



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,427	01/08/2001	Koichi Hayakawa	112857-247	5517
29175	7590	04/21/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/756,427	<b>Applicant(s)</b> HAYAKAWA, KOICHI	
	<b>Examiner</b> Traci L Smith	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on January 21, 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is in response to papers filed on January 21, 2005.
2. No claims were amended.
3. Claims 1-25 are pending.
4. Claims 1-25 are rejected.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11 and 13-21 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,910,776 Black, June 8, 1999, filed on December 4, 1996.
6. As to claims 1,14-16 and 24-25 Black teaches a method, apparatus and medium for identifying and monitoring electronic equipment via a signal(Abstract(57) I.1-5)
7. with means for acquiring product information and other data which can be changed or updated(C. 3 I. 13-15)
8. –with a means for storage of information(C.3 I. 16-17)
9. As to claims 2-3 and 17-18 Black teaches a method and apparatus of an information signal that travels via a any type of network.(C. 4 I. 8-11).
10. As to claim 4; Black teaches a method and apparatus of product information storage means.(C. 4 I. (34-36)
11. As to claims 5 and 19 Black teaches a method and apparatus of a identification reader.(C. 4 I. 7-9)

12. As to claims 6 Black teaches an method and apparatus information reading means from computer system( C. 4 l. 49-52)
13. As to claims 7 and 20 Black teaches a method and apparatus with a monitor displaying means for displaying information. (Fig. 5 Ref. 61).
14. As to claim 8 Black teaches means for updating and inputting information.(C. 4 l. 31-33).
15. As to claims 9 and 21 Black teaches a method and apparatus of having a connection for transmitting information.(C. 3 l. 63-64)
16. As to claims 10-11 Black teaches a method and apparatus of Read Only Memory. (C. 3 l. 17-18)
17. As to claims 13 and 23 Black teaches a method and apparatus of equipment information and maintenance schedule(C. 4 l. 22-30).

***Claim Rejections - 35 USC § 103***

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,910,776 Black, June 8, 1999, filed on December 4, 1996 as applied to

claims 1-11 and 13-21 and 23-25 above, and further in view of US Patent 5,745,036 Clare, April 28, 1998.

20. As to claim 12 and 22 Black teaches a method and apparatus for identifying and monitoring electronic equipment via a signal. However, Black fails to teach a purchase information that comprises specific information regarding the electronic equipment. Clare teaches an electronic article security system that monitors articles and contains purchase information such as store number and date of purchase.(Fig. 4 Ref 36.) It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Clare with Black as they both are RFID apparatuses used for monitoring electronic equipment.

### ***Response to Arguments***

21. Applicant's arguments filed January 21, 2005 have been fully considered but they are not persuasive.

22. As to applicants arguments that the cited reference does not disclose the means plus function language regarding acquiring control information and updating means. Applicant does not point out what aspect of the structure the reference fails to disclose. The examiner believes the cited reference does disclose the necessary information therefore the rejection stands.

23. As to applicants arguments regarding the references Black and Clare do not disclose acquiring purchasing purchase and repair information. Examiner notes that the claim states "at least one" therefore the reference only needs to teach one of the listed

Art Unit: 3629

items. Black teaches repair information at C. 4 I. 27-30 where maintenance schedules and calibration information is maintained. Clare teaches purchasing information in C. 6 I. 26).

24. As to applicants arguments that Black fails to teach updating product information examiner points to C. 3 I. 12-15 where it teaches..."product information, specific instructions and other data for automated operations which can be changed or updated."

25. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner disagrees with applicants argument that one of ordinary skill in the art would not be motivated to combine the teachings of Clare with Black because Black does not teach purchase information. Examiner believes one of ordinary skill in the art would look to other areas where RFID tracking is used for electronic products. Both Black and Clare use the tracking device to determine the location of the product.

***Conclusion***

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls

  
